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PATENT
08/828,022



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPEAL FROM THE EXAMINER TO THE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Amir M. Saffarian
Serial No.: 08/828,022
Filing Date: March 27, 1997
Group Art Unit: 2876
Examiner: Jamara A. Franklin
Title: AUTOMATED SYSTEM AND METHOD FOR
CHECK AMOUNT ENCODING AT A POINT-OF-
SALE

BOARD OF APPEALS AND INTERFERENCES
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to this Board from the decision of the Examiner, contained in a Final Office Action mailed August 12, 2003, finally rejecting Claims 19, 22, 25, and 26. Appellant respectfully submits this Appeal Brief, in triplicate, along with the statutory fee of \$330.00 under 37 C.F.R. § 1.17(c), and a Notice of Appeal.

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REAL PARTY IN INTEREST

The present application was assigned to Electronic Data Systems Corporation, a Texas corporation, as indicated by an assignment from the inventor recorded on March 27, 1997 in the Assignment Records of the United States Patent and Trademark Office at Reel 8485, Frame 0052. There is of record a merger of Electronic Data Systems Corp., a Texas corporation into Electronic Data Systems Corp., a Delaware corporation recorded on January 26, 1999 in the Assignment Records of the United States Patent and Trademark Office at Reel 9710, Frame 0976.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellant, the undersigned Attorney for Appellant, or the Assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 19, 22, 25, and 26 were rejected in the Final Office Action mailed August 12, 2003. Claims 19, 22, 25, and 26 are presented for appeal and set forth in the Appendix hereto.

STATUS OF AMENDMENTS

A Response to Examiner's Final Office Action of August 12, 2003, was filed on September 11, 2003. There were no amendments made to the claims at that time.

SUMMARY OF INVENTION

According to one embodiment of the present invention, a portable check encoding device (200) is provided that includes an input device (208) that receives a check amount from a user and a display (206) that is coupled to the input device (208) and that displays the check amount entered by the user. (Page 6, Line 33 to Page 7, Line 12; Page 7, Lines 27-34). The portable check encoding device (200) also includes a portable check printer that is coupled to the input device (208) and that receives the check amount from the input device (208) and encodes the check amount in magnetic ink at a predetermined location on a check (300). (Page 8, Lines 1-33).

In accordance with another embodiment, a pocket-sized personal check encoder (200) includes a keypad (208) having a plurality of alphanumeric keys operable to receive a check amount from a user. A display (206) is also included that is coupled to the keypad (208) and operable to display the check amount entered by the user. In addition, a check encoder (204) is included that is coupled to the keypad (208) and the display (206) and is operable to receive the check amount from the keypad (208) and encode the check amount in a machine-readable format at a predetermined location on a check (300). (Page 4, line 33 to Page 5, line 6). The check encoder (204) may be integrated with input device (208) and display (206) to form a unit that performs the functions of both. (Page 8, lines 24-28).

ISSUES

1. Did the Examiner err in concluding that Claims 19, 22, 25, and 26 are not patentable under 35 U.S.C. §102(b) in light of U.S. Patent 4,623,965 issued to Wing (hereinafter "*Wing*").

GROUPING OF CLAIMS

Pursuant to 37 C.F.R. § 1.192(c)(7), Claims 19, 22, 25, and 26 may be deemed to stand or fall together for purposes of this appeal. This grouping is consistent with the grounds of rejection that Appellant is appealing.

ARGUMENTS

Claims 19, 22, 25, and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 4,623,965 issued to *Wing*. This rejection is respectfully traversed for the following reasons.

Independent Claim 19 recites:

19. A portable check encoding device, comprising:
an input device operable to receive a check amount from a user and further operable to receive a payee name selected from a list of payee names by the user;
a memory operable to store and recall the list of payee names;
a display operable to display the check amount entered by the user and the list of payee names; and
a portable check printer operable to:
receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and

receive the selected payee name and print the selected payee name in a payee field on the check.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*). In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)). Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

Using the preceding well-settled jurisprudence, it is clear that *Wing* fails to anticipate Independent Claim 19. For example, *Wing* fails to teach, suggest, or disclose a portable check printer operable to: receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and receive the selected payee name and print the selected payee name in a payee field on the check, as recited in Independent Claim 19. In contrast to the subject matter of Independent Claim 19, the *Wing* patent is directed to an apparatus with its primary purpose being to maintain, print, and record deposits and withdrawals from a checking account. (See *Wing*, Column 1, lines 5-8.) Other features of the apparatus include the capability to void checks and deposits that have previously been recorded and to make adjustments to a corresponding account. (See *Wing*, Column 1, lines 28-30.)

Applicant is both perplexed and confused by the surprise reappearance of *Wing*, as its deficiencies were well-documented by both the Examiner and Applicant. This is evidenced by the file history of the present Application. Applicant is equally astounded at the metamorphosis that *Wing* has ostensibly undergone. Once used as a supplementary reference

under §103, which the Examiner used to purportedly teach only a part of the present invention, the Examiner now contends that *Wing* has progressed into a prior art reference that suddenly teaches all of the limitations of the pending claims.

The Examiner previously explained: "*Wing* lacks the teaching of a check printer encoding the check amount in magnetic ink at a predetermined location." (See page 2 of Office Action of February 8, 2002.) In addition, without solicitation from Applicant, the Examiner further made it clear that: "[the] *Wing/Schultz* [combination] lack[s] the teaching of an input receiving a payee name selected from a list of payee names by the user, a memory operable to store and recall the list of payee names, and a display to display the list of payee names." (See page 2 of Office Action of February 8, 2002.) In both cases, the Examiner was correct; *Wing* suffers from these shortcomings as well as others that result in it not being related to the patentability of the pending claims. Accordingly, *Wing* continues to lack the necessary disclosure to anticipate Independent Claim 19. Therefore, based on the Examiner's own admission and the subject matter of *Wing*, it is impossible that such a reference anticipates Independent Claim 19. For at least these reasons, Independent Claim 19 is patentable over *Wing* and notice to this effect is respectfully requested.

Claims 22, 25, and 26 depend from Independent Claim 19 and add a limitation that further distinguishes them. Thus, Claims 22, 25, and 26 are also allowable for at least the reasons identified above. Notice to this effect is respectfully requested.

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over all the art cited of record, either alone or in combination. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is hereby authorized to charge the \$330.00 fee for this Appeal Brief, the \$110.00 fee for a one (1) month extension of time fee, and any fee connected with this communication to Deposit Account No. 05-0765 of Electronic Data Systems Corporation. The Commissioner is also hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

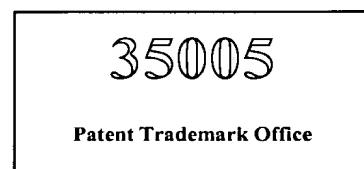
Respectfully submitted,
BAKER BOTTS L.L.P.
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Reg. No. 47,232

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APPENDIX — CLAIMS PRESENTED ON APPEAL

19. A portable check encoding device, comprising:
 - an input device operable to receive a check amount from a user and further operable to receive a payee name selected from a list of payee names by the user;
 - a memory operable to store and recall the list of payee names;
 - a display operable to display the check amount entered by the user and the list of payee names; and
 - a portable check printer operable to:
 - receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and
 - receive the selected payee name and print the selected payee name in a payee field on the check.
22. The portable check encoding device, as set forth in claim 19, wherein the check printer is operable to encode the check amount on a MICR line of the check.
25. The portable check encoding device, as set forth in claim 19, wherein the check printer is further operable to print the check amount alphabetically in an alphabetical amount field and numerically in a numerical amount field on the check.
26. The portable check encoding device, as set forth in claim 19, wherein the check received by the check printer is a blank check, the blank check including an account number but not a payee name or check amount.



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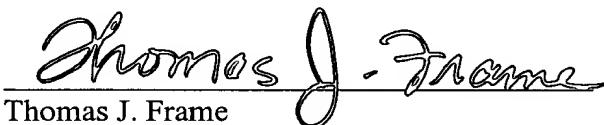
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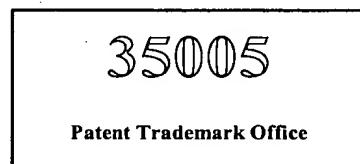
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